

REMARKS/ARGUMENTS

Claims 1-, 3-10 and 12-20 are pending in this case.

A. Rejections under 35 U.S.C. 103.

Claims 1, 3, 4, 6, 7, 9, 10, 12-14, 16, 17 and 19 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,283,904 to Carson et al. in combination with Jones et al. Claims 5, 8, 15, 18 and 20 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,283,904 to Carson et al. in combination with Jones et al. and further in view of Circello. These rejections are respectfully traversed.

As pointed out in the Response filed on May 7, 2003 with a continued prosecution application, it is respectfully believed that Jones et al. is not available as a reference under 35 U.S.C. 103. Jones et al. reference shares a common inventor (Andrew M. Jones) as the present invention. Further, the owner of the Jones et al. reference, STMicroelectronics, Ltd. is the same as the owner of the instant application. It would appear that Jones et al. would only be available as a reference under 35 U.S.C. 102(e) or (f). However, under 35 U.S.C. 103(c), the Jones et al. reference is not available as a reference because the reference and the claimed invention were, at the time the invention was made, owned by the same person or were subject to an obligation of assignment to the same person.

The Continued Prosecution Application filed on May 7, 2003 ensures applicability of the AIPA amendments to 35 U.S.C. 103(c) in this case. The Appendix to this response includes information from the "American Inventor's Protection Act of 1999 Questions and Answers" web page for the Examiner's

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convenience. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. 103 be withdrawn.

For the reasons given above, all pending claims 1, 3-10 and 12-20 are believed to be allowable and the case in condition for allowance.

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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E. 103(c)**E1. Does a Continued Prosecution Application qualify for the new provisions of 35 U.S.C. 103 (c) as specified in Section 4807 of the American Inventors Protection Act?**

Yes, see Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999, Notice, 1233 OG 54 (April 11, 2000).

E2. Under the amended 35 U.S.C. 103(c), what type of evidence will provide proof that the inventions were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made?

To disqualify a reference under 35 U.S.C. 103(c), applicant needs to supply evidence that the invention described in the application for patent and the invention described in the "prior art" reference applied against the application were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention in the application for patent was made. The time requirement "at the time the invention was made" is required by statute. See 35 U.S.C. 103(c).

Applications and references will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Thus, a statement, by itself, will be sufficient evidence. For a more detailed explanation, see the "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 OG 96 (Dec. 26, 2000).

E3. What applications qualify for the prior art exclusion of 35 U.S.C. 103(c), as amended by the AIPA, of commonly owned or assigned prior art? (Posted on 12/6/01; updated 8/01/02)

The amendment to 35 U.S.C. 103(c) made by the AIPA is effective for applications filed on or after November 29, 1999. For the National Stage (35 U.S.C. 371) of International Applications, the international filing date must be on or after November 29, 1999 in order for applicant to invoke the exclusion of prior art under 35 U.S.C. 103(c) as amended by the AIPA. The date the applicant fulfilled the requirements of 35 U.S.C. 371(c)(1), (2) and (4) is not relevant in determining whether the application is entitled to the prior art exclusion under 35 U.S.C. 103(c) as amended by the AIPA. If a continuing application is filed after November 29, 1999, and claims the benefit of the prior international application filed prior to November 29, 1999, such continuing application would be entitled to revised exclusion provided in 35 USC 103(c). See "Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999," Notice, 1233 OG 54 (April 11, 2000) and "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 USC 103

(c)," Notice, 1241 OG 96 (Dec. 26, 2000).

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